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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/860,007	08/04/1997	RALF BERSCHIED	62-209-45694	8493
20736	7590	01/14/2004	EXAMINER	
MANELLI DENISON & SELTER 2000 M STREET NW SUITE 700 WASHINGTON, DC 20036-3307			SHIPPEN, MICHAEL L	
			ART UNIT	PAPER NUMBER
			1621	30

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/860,007

Applicant(s)

BERSCHIED, ET AL.

Examiner

MICHAEL L. SHIPPEN

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003 and 14 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8, 13, 14, 16-26 and 28-47 is/are pending in the application.
- 4a) Of the above claim(s) 19, 20, 28-32 and 36-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 13, 14, 16-18, 21-26 and 33-35 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 19, 20, 28-32 and 36-47 stand withdrawn from consideration as not reading upon the elected invention or species. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

The rejection of claim 26 under 35 U.S.C. § 112, first and second paragraphs, has been obviated by applicants' amendment.

Claim Rejections - 35 USC § 103

Claims 8, 14, 16-18, 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over HOPP (USP 4,110,430) for reason of record.

Applicants assert that the experimental evidence disclosed in the specification demonstrates unexpected advantages of the claimed compounds compared to the compounds of HOPP. It is unclear what evidence in the specification applicants are relying upon and they do not point to any specific evidence. It is noted that in Paper No. 13 it was pointed out to applicants that the tables set forth in the specification have been carefully considered but not found persuasive of patentability. The tables do not make any direct comparison of a prior art compound with the structurally closest claimed compounds. As such there is no evidence that the claimed compounds possess unexpectedly superior properties or properties different from the prior art. Applicants simply do not address this point. It is of no moment that the prior art does not teach the

Art Unit: 1621

same activity or utility for the prior art compounds as that described by applicants. The skilled artisan need possess only some motivation to modify the prior art compound, and that such motivation need not coincide with the one driving an applicant. The motivation is related to the uses one skilled in the art would expect that compound to have upon analyzing the prior art. That an applicant comes upon a use of a compound that is not taught by the prior art does not speak to the compound's nonobviousness. *In re Shetty*, 195 USPQ 753 (CCPA 1977); *In re Lintner*, 173 USPQ 560 (CCPA 1972); *In re Hoch*, 166 USPQ 406 (CCPA 1970). Applicants' discussion of the facts of each of these cases is noted, but does not change the fact here that there is no actual evidence of any differences in properties between the prior art compounds and the closest claimed compounds.

Applicants assert that the declaration filed under 37 CFR 1.132 on September 23, 2003 show that lipophily and topology play a major role in the biocidal activity of the instant compounds. The declaration has been carefully considered but not found persuasive of patentability. First, whether or not this is the case it does not demonstrate that the claimed compounds possess unexpectedly superior properties or properties different from the prior art. It is particularly noted that as to all of the compounds tested in the declaration there is no direct comparison of a prior art compound with the structurally closest claimed compounds. As such there is no evidence that the claimed compounds possess unexpectedly superior properties or properties different from the prior art.

Applicants' assertion that motivation is lacking is not seen for the reasons set forth in the last action.

Claims 8, 13, 14, 16-18, 21-25 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over SIPOS (USP 4,321,257) for reasons of record.

Applicants point to the fact that the reference does not teach applicants properties. It is of no moment that the prior art does not teach all the same activity or utility for the prior art compounds as that described by applicants. The skilled artisan need possess only some motivation to modify the prior art compound, and that such motivation need not coincide with the one driving an applicant. The motivation is related to the uses one skilled in the art would expect that compound to have upon analyzing the prior art. That an applicant comes upon a use of a compound that is not taught by the prior art does not speak to the compound's nonobviousness. *In re Shetty, supra*; *In re Lintner, supra*; *In re Hoch, supra*. Applicants' discussion of the facts of each of these cases is noted, but does not change the fact here that there is no actual evidence of any differences in properties between the prior art compounds and the closest claimed compounds.

Applicants assert that the declaration filed under 37 CFR 1.132 on September 23, 2003 show the instant compounds possess unexpectedly high activity. The declaration has been carefully considered but not found persuasive of patentability. First, applicants' argument ignores the fact that claims 21, 22 and 24 read on agents specifically taught in the reference, note lines 43-53 of column 5. Second, as to all of the compounds tested in the declaration there is no direct comparison of a prior art

Art Unit: 1621

compound with the structurally closest claimed compounds. As such there is no evidence that the claimed compounds possess unexpectedly superior properties or properties different from the prior art compounds.

Applicants' discussion of the Chem. Ber. article is noted but not found persuasive. This article has been considered only to the extent of the translation provided by applicants in their response. First, there is no correlation to the steric effects shown in the dye molecules in the reference to the instant compounds. It is noted that the compounds shown in the article are structurally quite remote from the compounds at issue here. The fact that there exist other nonrelated compounds that may have unexpected properties, does not show that the instant compounds possess unexpected properties.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over HAFNER (USP 4,968,668) in view of VOGEL (A Textbook of Practical Organic Chemistry) for reasons of record.

Applicants assert that there is no motivation to follow claimed step (a) with claimed steps (b) through (d). Inherent in any process is the necessity of obtaining the starting materials. This almost always necessitates the starting material to have been prepared by some synthetic method. Even a commercial product has been synthesized. One would be motivated to use a known method of synthesis since this would afford the starting material needed. This is common practice. Otherwise one would have to ignore the known methods of preparation and with the expenditure of a

Art Unit: 1621

great deal of time and expense develop novel methods of preparations. This is merely common sense.

Applicants' argument there is no motivation to use a different starting material or form different products is not found persuasive. First, the claim as now amended reads on reactants and products of HAFNER. As such the argument is not relevant to such reactants and products. To the extent, the claim reads on still other reactants and products not specifically disclosed by HAFNER, there is adequate motivation for reasons set forth in the last Office action.

Applicants' reliance upon MPEP 706.04 is not seen. Applicants' argument simply ignores the prosecution of this application. It is noted that the rejections criticized by applicants were made after applicants amended their claims. First, such an amendment in of itself would normally necessitate further search of the amended claims. Second, when the present examiner was assigned the instant application to be examined, there were no search notes present in the file wrapper. As such there was in fact no search to give full faith and credit to. Applicants should further note, the instant examiner is a primary examiner and as such the rejections have been approved by a primary examiner in accordance with the procedure set forth in MPEP 706.04. Furthermore, applicants' argument ignores fundamental principles of patent law. The fact that a claim has been indicated allowed is simply immaterial as to the validity of the rejection. This is a question of procedure and not substance. As such, applicants are advised that if they feel that the examiner has proceeded improperly by conducting a prior art search

Art Unit: 1621

during his examination of the amended claims or if they feel that the examiner should have ignored pertinent prior art, then this is a petitionable matter and not appealable.


Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(703) 308-4635**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1235**. The official group FAX machine number is **(703) 308-4556**.

MShippen
January 12, 2004


MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621